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cancel
wagering interface displays a screen containing the video advertisements and wagering-related content on the monitor.

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100. (Amended) The user terminal defined in claim 97 wherein the receiver receives racing videos and wherein the interactive wagering interface simultaneously displays the video advertisements and the racing videos on the screen.

REMARKS

Introduction

Claims 1-105 were pending in the above-identified patent application. Claim 10 has been cancelled. Claims 1, 4, 5, 9, 14, 22, 32, 35, 52, 65, 66, 73, 75, 76, 81, 83, 84, 94, 97, and 100 have been amended. Annexed hereto is an Appendix showing the changes that have been made to the claims.

The Examiner provisionally rejected claims 1-105 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-115 of copending application No. 09/373,120.

The Examiner rejected claims 1-4, 10-14, 22-36, 65-82, and 94-100 under 35 U.S.C. § 103(a) as being unpatentable over Algie U.S. Patent No. 5,564,977 (hereinafter "Algie") in view of Ueno U.S. Patent No. 5,746,657 (hereinafter "Ueno"). Claims 5-9, 15-21, 37-64, 83-93, and 101-105 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and Ueno and further in

view of Handelman U.S. Patent No. 5,539,450 (hereinafter "Handelman").

The Examiner's rejections are respectfully traversed.

Claim Amendments

Claim 10 has been cancelled. Claims 1, 4, 5, 9, 14, 22, 32, 35, 52, 65, 66, 73, 75, 76, 81, 83, 84, 94, 97, and 100 have been amended to more particularly define the invention.

Provisional Obviousness-Type Double Patenting Over Claims 1-115 Of Copending Application No. 09/373,120

Claims 1-105 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-115 of copending application No. 09/373,120. The Examiner should continue to make this "provisional" double patenting rejection as long as there are conflicting claims in these two applications unless the "provisional" double patenting rejection is the only rejection remaining in this application. If the "provisional" double patenting rejection is the only rejection remaining in this application, then the Examiner should withdraw the rejection and permit this application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application into a double patenting rejection at the time when this application issues as a patent. See MPEP § 804(I)(B).

The Ueno Reference

Claims 1-4, 10-14, 22-36, 65-82, and 94-100 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie in view of Ueno. Claims 5-9, 15-21, 37-64, 83-93, and 101-105 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and Ueno and further in view of Handelsman.

Applicants, in the Reply to Office Action dated June 4, 2001, stated that Ueno is not prior art because applicants' priority date is earlier than Ueno's U.S. filing date. Notwithstanding, the Examiner states in the current Office Action that Ueno is being used to show a universal fact and, therefore, this is an exception to the rule that the critical date of a reference must precede the filing date under MPEP § 2123. Applicants submit that "a place to make wagers" is not a universal fact under this exception. Universal facts under this exception include characteristics and properties of a material or a scientific truism. See MPEP § 2123. "A place to make wagers" is in no way similar to a material property or a scientific truism. Nevertheless, applicants concede that "a place to make wagers" has been known prior to applicants' priority date. This is stated in the background of applicants' specification.

In addition, Algie discloses a display apparatus for a betting parlor (see the abstract of Algie). Therefore, Algie discloses "a place to make wagers." Applicants, therefore, see no need for the Examiner to rely on Ueno for this fact.

While the Examiner claims that Ueno is only being used to show a universal fact, the Examiner contends that Ueno discloses advertising. This statement is contrary to the Examiner's position that Ueno is being used to show the universal fact of "a place to make wagers." Furthermore, the Examiner contends that it would have been obvious to apply the teachings of Ueno to the disclosed system of Algie. As discussed above, the exception under MPEP § 2123 applies to universal facts, not teachings.

Accordingly, applicants will address the rejection of claims 1-4, 10-14, 22-36, 65-82, and 94-100 as over Algie in view of "a place to make wagers" and the rejection of claims 5-9, 15-21, 37-64, 83-93, and 101-105 as being unpatentable over Algie and "a place to make wagers" and further in view of Handelman.

Applicants' Reply To The Rejections
Of Claims 1-3, 10-31, 65-74, And 94-96

Claims 1-3, 10-14, 22-31, 65-74, and 94-96 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie in view of "a place to make wagers." Claims 15-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and "a place to make wagers" and further in view of Handelman. The Examiner's rejections are respectfully traversed.

Applicants' invention, as defined by independent claims 1, 65, and 94, is directed to systems and a method for interactive wagering on races using a user terminal that is

remote from any racetrack. A plurality of screens having wagering related content is displayed using the user terminal. One of the plurality of screens includes information on available tracks at which races are to be run. The user terminal allows the user to place a wager on a given race at one of the available tracks that has not been run. Advertising information is displayed on at least one of the plurality of screens.

Algie, as described above, discloses a display apparatus for a betting parlor. The display apparatus displays racing and parimutuel data. One or more lines of the display apparatus can be used for sponsors' advertisements.

The Examiner contends that it would have been obvious to apply a "place to make wagers" to the system of Algie in order to permit bettors to make wagers using information supplied by Algie's system. The Examiner's contention, however, is the object of Algie's invention. The first stated object of Algie is to provide betting information to excite bettors into placing wagers at a betting parlor (i.e., a "place to make wagers"). Nevertheless, Algie fails to disclose or suggest (a) displaying a plurality of screens having wagering related content using a user terminal, wherein one of the plurality of screens includes information on available tracks at which races are to be run, (b) using the user terminal to allow the user to place a wager on a given race at one of the available tracks that has not been run, and (c) displaying advertising information on at least one of the plurality of screens as specified in claims 1, 65, and 94.

The Examiner states that Algie "discloses the broadly claimed invention except the reference lacks clearly disclosing a place to make wagers; although the reference discloses a keyboard connected to the system" (page 4 of the 8/29/01 Office Action). The Examiner apparently contends that the keyboard disclosed in Algie can be used to allow users to make wagers. This is not so. There is no disclosure in Algie that shows or suggests that the keyboard of Algie can be used to allow a user to place a wager. The keyboard is in communication with CPU 11, which receives racing information and drives the display boards for displaying the racing information. The system of Algie, as disclosed, is not capable of processing a wager. Furthermore, because the display apparatus of Algie is used at betting parlors, there is no motivation to modify the display apparatus of Algie to add the additional functionality of allowing a user to place a wager.

Accordingly, for at least these reasons, independent claims 1, 65, and 94 are allowable over Algie in view of "a place to make wagers." Dependent claims 2, 3, 11-31, 66-74, 95, and 96 are allowable because independent claims 1, 65, and 94, from which they depend, are allowable. Applicants, therefore, request that the rejection of claims 1-3, 11-31, 65-74, and 94-96 be withdrawn.

Applicants' Reply To The Rejections
Of Claims 4, 32-51, 75-82, And 97-105

Claims 4, 32-36, 75-82, and 97-100 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie in view of "a place to make wagers." Claims 37-51 and 101-105 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and "a place to make wagers" and further in view of Handelsman. The Examiner's rejections are respectfully traversed.

Applicants' invention, as defined by independent claims 4, 75, and 97, is directed to systems and a method for interactive wagering on races using a user terminal that is remote from any racetrack. The user terminal is used to display a screen containing a video advertisement and wagering-related content. The user terminal allows the user to place a wager on a race that has not been run.

The Examiner contends that the combination of Algie and "a place to make wagers" discloses applicants invention as defined by claims 4, 75, and 97. However, as described above, the combination of Algie and "a place to make wagers" fails to disclose or suggest (a) using a user terminal to display a screen containing an advertisement and wagering-related content and (b) using the user terminal to allow the user to place a wager on a race that has not been run as specified in claims 4, 75, and 97. Moreover, the combination fails to disclose or suggest displaying a video advertisement as specified in claims 4, 75, and 97.

Accordingly, for at least these reasons, independent claims 4, 75, and 97 are allowable over Algie in view of "a place to make wagers." Dependent claims 32-51, 76-82, and 98-105 are allowable because independent claims 4, 75, and 97, from which they depend, are allowable. Applicants, therefore, request that the rejection of claims 1-3, 10-31, 65-74, and 94-96 be withdrawn.

Applicants' Reply To The Rejection
Of Claims 5-9, 52-64, And 83-93

Claims 5-9, 52-64, and 83-93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Algie and "a place to make wagers" and further in view of Handelman. The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by independent claims 5 and 83, is directed to a system and method for interactive wagering on races using a user terminal that is remote from any racetrack. A plurality of screens having wagering related content is displayed using the user terminal. One of the plurality of screens includes information on races that have not been run and one of the plurality of screens provides the user with an opportunity to order merchandise. The user terminal allows the user to place a wager on one of the races that has not been run.

Handelman discloses providing additional services to users of a pay television network. In one preferred embodiment,

a pay television shopping system is provided. FIG. 34 shows an illustrative shopping display screen. Accounting apparatus is connected to the pay television shopping system for settling shopping debts. In another preferred embodiment, a pay television gaming system is provided. FIG. 35 shows an illustrative gaming display screen. Accounting apparatus is connected to the pay television gaming system for settling gaming debts.

The Examiner contends that it would have been obvious to apply the teachings found in Handelman to the system of Algie and "a place to make wagers" in order to capitalize on the "spur of the moment" want of players seeing products for sale. Handelman, however, is directed to providing additional services to users of a television network, whereas Algie is directed to providing racing information at "a place to make wagers." Handelman and Algie are nonanalogous art. Algie is in no way similar to a pay television network. Therefore, applicants submit that it would not have been obvious to modify Algie with the teachings of Handelman. Furthermore, Algie fails to disclose or suggest any type of user terminal. Algie displays racing information on display boards at "a place to make wagers." The keyboard, as discussed above, is in communication with the apparatus that drives the display boards. Applicants, therefore, submit that the keyboard is associated with an operator of the system, not bettors at "a place to make wagers." Therefore,

applicants submit that it would not be possible to modify Algie with the teachings of Handelman.

Moreover, even assuming *arguendo* that it would be possible to modify Algie with the teachings of Handelman, applicants submit that the rejection still fails because the combination of Algie, "a place to make wagers," and Handelman fails to disclose or suggest (a) displaying a plurality of screens having wagering related content using a user terminal, wherein one of the plurality of the screens includes information on available tracks at which races are to be run and one of the plurality of screens provides the user with an opportunity to order merchandise and (b) using the user terminal to allow the user to place a wager on one of the races that has not been run as specified in claims 5 and 83.


Accordingly, for at least these reasons, independent claims 5 and 83, and dependent claims 6-9, 52-64, and 84-93, are allowable over Algie, "a place to make wagers," and Handelman. Applicants, therefore, request that the rejection of claims 5-9, 52-64, and 83-93 be withdrawn.

Conclusion

In view of the foregoing, claims 1-9 and 11-105 are in condition for allowance. This application is therefore in

condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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APPENDIX

Showing How The Claims Have Been Amended

In The Claims

Please cancel claim 10.

Please amend claims 1, 4, 5, 9, 14, 22, 32, 35, 52, 65, 66, 73, 75, 76, 81, 83, 84, 94, 97, and 100 as follows:

1. (Twice Amended) A method for interactive wagering on races with a user terminal that is remote from any racetrack, comprising:

displaying a plurality of screens having wagering-related content on a monitor connected to the user terminal, wherein one of the plurality of screens includes information on available tracks at which races are to be run [using the user terminal];

using the user terminal to allow the user to place a wager with the user terminal on a given race at one of the available tracks that has not been run; and

displaying advertising information on [a monitor connected to the user terminal] at least one of the plurality of screens.

4. (Twice Amended) A method for interactive wagering on races with a user terminal that is remote from any racetrack, comprising:

using the user terminal to display a screen containing a video advertisement and wagering-related content; and

allowing a user to place a wager with the user terminal on a given race that has not been run.

5. (Amended) A method for interactive wagering on races with a user terminal that is remote from any racetrack, comprising:

using the user terminal to display a plurality of screens having wagering-related content, wherein one of the plurality of screens includes information on races that have not been run;

allowing [the] a user to place a wager with the user terminal on a given one of the races that has not been run; and

using [the user terminal] one of the plurality of screens to provide the user with an opportunity to order merchandise.

9. (Amended) The method defined in claim 5 further comprising simultaneously displaying advertising and racing videos [using the user terminal] on one of the plurality of screens.

14. (Amended) The method defined in claim 1 further comprising simultaneously displaying the advertising information and racing videos [using the user terminal] on one of the plurality of screens.

22. (Amended) The method defined in claim 1 further comprising [using the user terminal to display] displaying information on the given race on at least one of the plurality of screens.

32. (Amended) The method defined in claim 4 wherein the screen containing the video advertisement is [the screen of] displayed on a monitor connected to the user terminal.

35. (Amended) The method defined in claim 4 [further comprising simultaneously displaying the video advertisement and] wherein the wagering-related content is racing videos [using the user terminal].

52. (Amended) The method defined in claim 5 wherein the [information on races is] plurality of screens are displayed on a monitor connected to the user terminal.

65. (Amended) An off-track wagering system for interactively wagering on races that is remote from any racetrack, comprising:

a user terminal for displaying a plurality of screens having wagering-related content, wherein one of the plurality of screens includes information on available tracks at which races are to be run, wherein the user terminal allows a user to place a wager on a given one of the races to be run, and wherein the user terminal displays advertising information on at least one of the plurality of screens; and

a video and data distribution facility for providing the advertising information and the information on the available tracks to the user terminal.

66. (Amended) The system defined in claim 65 [further comprising displaying the advertising and the information on available tracks], wherein the plurality of screens are displayed on a monitor connected to the user terminal.

73. (Amended) The system defined in claim 65 wherein the video and data distribution facility is configured to provide racing videos to the user terminal.

75. (Amended) An off-track wagering system for interactively wagering on races that is remote from any racetrack, comprising:

a user terminal for displaying a screen containing a video advertisement [on a screen] and wagering-related content

and for allowing a user to place a wager on a given race to be run; and

a video and data distribution facility for providing the video advertisement to the user terminal.

76. (Amended) The system defined in claim 75 further comprising displaying [the video advertisement] the screen on [the screen of] a monitor connected to the user terminal.

81. (Amended) The system defined in claim 75 wherein the video and data distribution facility is configured to provide racing videos to the user terminal.

83. (Amended) An off-track wagering system for interactively wagering on races that is remote from any racetrack, comprising:

a user terminal for displaying a plurality of screens having wagering-related content, wherein one of the plurality of screens includes information on races that have not been run, wherein the user terminal allows a user to place a wager on a given one of the races that has not been run, and wherein [the user terminal] one of the plurality of screens provides the user with an opportunity to order merchandise; and

a video and data distribution facility for providing the information on races to the user terminal.

84. (Amended) The system defined in claim 83 [further comprising displaying the information on races] wherein the plurality of screens are displayed on a monitor connected to the user terminal.

94. (Amended) A user terminal for use in a user's home that allows the user to place a wager on a race that has not been run, comprising:

a receiver that receives advertising information and information on racetracks; and

a processor that presents an interactive wagering interface on a monitor, wherein the user can place wagers using the interactive wagering interface and wherein the interactive wagering interface displays a plurality of screens having wagering-related content on the monitor, wherein one of the plurality of screens includes the advertising information and one of the plurality of screens includes the information on racetracks [on the monitor].

97. (Amended) A user terminal for use in a user's home that allows the user to place a wager on a race that has not been run, comprising:

a receiver that receives video advertisements; and

a processor that presents an interactive wagering interface on a monitor, wherein the user can place wagers using the interactive wagering interface and wherein the interactive

wagering interface displays a screen containing the video advertisements and wagering-related content on the monitor.

100. (Amended) The user terminal defined in claim 97 wherein the receiver receives racing videos and wherein the interactive wagering interface simultaneously displays the video advertisements and the racing videos on the screen.